

DETAILED ACTION

Status of the claims: Claims 1-21 are currently pending.

Priority: This application is a 371 of PCT/JP04/19578 (12/27/2004) and claims foreign priority to JAPAN 2003-431680 (12/26/2003), JAPAN 2004-283082 (09/29/2004), JAPAN 2004-312335 (10/27/2004).

Election/Restrictions

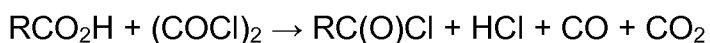
Applicant's election without traverse of Group II (claims 1-7, 9, and 20) in the reply filed on 12/22/08 is acknowledged. Applicant also elected the species of example 14. Because the generic claim 1 was found unpatentable, the provisional election of species is placed in effect and the claims are restricted to the elected species only and the subject matter not reading thereupon is withdrawn from consideration.

Claim Rejections - 35 USC § 103

1. Claims 1-7, 9, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al. (WO 02/053534 (cited in the IDS as equivalent of US 2003/0134859, now US 7,157,487) published in Japanese on 07/11/2002, references below are to the English '487 patent) in view of March's Advanced Organic Chemistry, 5th ed., (2001) ("March").

Applicant first argues that the feature of the claimed invention is that there is an acidic condition under which an amidation step is carried out between compounds (I) and (II). Applicant also alleges that the instant Example 14 reaction system is required to be acidic.

The reaction of the carboxylic acid with oxalyl chloride produces 1 equivalent HCl (not 2 equivalents as applicant asserts) as shown in the following equation:



Thus, the balance in the instant example 14 is 1.2 molar equivalent HCl and 1.3 molar equivalent triethylamine and the reaction mixture is *not* "clearly acidic overall."

Regardless, one of ordinary skill in the art would be motivated to combine the same reactants as disclosed by Nakayama and through the course of routine optimization of the reaction conditions, as is commonly done in the art, arrive at the instantly claimed invention because as March specifically teaches the acidity of the reaction can be adjusted in some cases.

Next applicant argues that example 66 of Nakayama is basic because the methylene chloride solvent is distilled off. This reasoning is not consistent with that which is well known in the art, specifically, removing an organic solvent such as methylene chloride only concentrates the residue and does not alter the basic or acidic character of the residue.

Next applicant characterizes March as teaching only basic conditions in the amidation on page 506-07 because the reference states "[i]n some cases aqueous alkali is added to combine with the liberated HCl." This characterization is not correct because the language clearly regards the norm as not have alkali and in *some cases* it is added. In fact, March points out that the conditions of the amidation reaction are acidic by nature. Thus applicant's attempt to distinguish the prior art from the claims are not persuasive.

Because none of applicant's arguments are found persuasive **the rejection is maintained.**

Claim Objections

2. Claims 4-7, 9 and 20 were objected to for being in an improper multiply dependent form. Applicant has appropriately amended the claims and the objection is **withdrawn.**

Conclusion

3. The claims are not in condition for allowance. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626